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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,523	03/09/2004	Robert A. Pyles	30-DMo-7093D/MD-02-	1934

157 7590 08/03/2004

BAYER MATERIAL SCIENCE LLC
100 BAYER ROAD
PITTSBURGH, PA 15205

EXAMINER

EINSMANN, MARGARET V

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 08/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/796,523

Applicant(s)

PYLES ET AL.

Examiner

Margaret Einsmann

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 13-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 13-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/904.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Applicant is requested to update the continuing data on the first page of the specification to include the patent number.

Applicant's preliminary amendment has been entered. Claims 1-12 have been canceled; claims 13-20 are pending.

Applicant is claiming a dyed polymeric molded article. In its narrowest embodiment the dyed article comprises an aromatic polycarbonate resin. The components or the dyebath do not remain in the dyed article. Accordingly, the claimed article can be rejected over a similar dyed resin article.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Brodmann, US 4,812,142.

Brodmann teaches dyeing polycarbonate lenses by immersing in a tinctorial amount of one dye in an organic solvent, which may be mineral oil. When that dye is one of the four disperse dyes listed at the top of column 2, the dyed article reads on claims 13-20. The first two are azo dyes, the next two are anthraquinone. The method of dyeing is described in col 2. Note that after dyeing the high boiling solvent and non-diffused dye are removed by rinse or scour, leaving the dye incorporated into the molded resin article.

Claims 13, 14, 16, 18-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious Sieloff, US 5,453,100. A polycarbonate sheet is dyed by coating with a solvent blend comprising a dye, washed with water and dried. The result was a uniformly colored polycarbonate sheet, anticipating the claims. See example 2 in col 5.

Claims 13-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious Bianco et al., US 3,514,246.

Aromatic polycarbonate resins are dyed with anthraquinone and azo disperse dyes. See list of dyes at the top of column 3. In example 1 the molded polycarbonate resin was dyed red, rinsed, soaped hot, rinsed and dried. No carrier thus remained in the molded article. Absence of evidence to the contrary, absent evidence to the contrary.

The disclosures of the above three patents anticipate the instant claims. The claims are obvious over the above three references taken individually for the following reasons:

The subject matter would have been obvious to the skilled artisan because the patentability of a product by process claim does not depend on its method of production and where the examiner has found a similar product, the burden rests with the applicant to prove that that product is patentably distinct. See *In re Thorpe*, 227 USPQ 964 (CAFC 1985); *In re Marosi et al*, 218 USPQ 289; *In re Pilkington*, 162 USPQ 145. "The lack of physical description in a product-by-process claim makes the determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not the process that must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad processes put before it and then obtain prior art products and make physical comparisons therewith." *In re Brown*, 173 USPQ 685,688 (CCPA 1972).

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: There is no basis in the specification for the polyurethane or alldiglycol carbonate to be included in the dyed products. In fact, regarding polyurethane, applicant states on page 4 lines 24-26 that polyurethane cannot be dyed


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at the temperature of 90-99°C. Applicant is required to delete those two resins from claim 13.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret Einsmann whose telephone number is 571-272-1314. The examiner can normally be reached on 7:00 AM -4:30 PM M-Th and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Margaret Einsmann
Primary Examiner
Art Unit 1751

July 29, 2004